

## REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks is respectfully requested. Upon entry of the present Amendment, Claims 1, 2, 4-6, 8-10, 12-14, 17, 18, 20, 21, and 23-33 will be pending. The Applicant asserts that the claims as amended and the newly added claims are allowable over the art of record.

Claims 1, 2, and 8 stand rejected under 35 U.S.C. § 102 as being unpatentable over U.S. Patent No. 5,482,030 to Klein ("the '030 reference"). Claims 4, 5, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,482,030 to Klein. Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,482,030 to Klein in view of U.S. Patent No. 6,026,807 to Punderbaugh et al. ("the '807 reference"). Claims 9 and 10 stand rejected under 35 U.S.C. § 102 as being unpatentable over U.S. Patent No. 4,817,822 to Rand et al. ("the '822 reference"). Claims 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,817,822 to Rand et al. Claim 14 stands rejected under 35 U.S.C. § 103 as unpatentable over Rand et al. in view of U.S. Patent No. 6,026,807 to Punderbaugh et al.

### 1. The Claims as Amended Overcome The Examiner's Rejections

The Application included three independent claims: 1, 9, and 17. Independent Claims 1 and 9 have been amended to include the recitation that the interactive element has an activated state and a deactivated state. Claims 1 and 9 also state that the interactive element is in the activated state in response to an actuating force applied to the interactive element and returns to the same deactivated state when the actuating force is removed. Independent Claim 17 has been amended to recite that when the interactive element is deactivated the interactive element returns to the same deactivated state.

Both the '030 reference and the '822 reference disclose aerosol spray counters that are indexed forward each time the spray container is depressed. The counter moves to the next successive number to record the number of doses delivered. Neither reference discloses an

interactive element that returns to the same deactivated state upon deactivation, as in the present invention. The intended purpose of these devices is to incrementally advance to the next number. Having a counter that returns to the same deactivated state would prevent these devices from operating as a counter. Moreover, it would not be obvious to modify the devices disclosed in the '030 and the '822 patents as disclosed in the present Application. As held by the Federal Circuit, it is not obvious to modify a device such that it renders the device inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Modifying the '030 and the '822 references such that they return to the same deactivated state, as disclosed in the present application, would render these devices inoperable for their disclosed purpose.

Accordingly, Independent Claims 1, 9, and 17 are in a condition for allowance. Reconsideration is earnestly solicited. In addition, Claim 8 has been amended to correct a typographical error. Claims 4, 5, 20, and 21 have been amended to correct antecedence due to the amendments to Claims 1, 9, and 17.

## 2. New Claims

The Applicant has added new claims 23-33. Claim 24 generally corresponds to Claim 1; Claim 25 generally corresponds to Claim 9; and Claim 26 generally corresponds to Claim 17. In each claim, the recitation of an "interactive character" has been replaced with the term "device" to broaden the scope of these claims.

The Applicant also added new Claim 24 that is also directed to "a device" as in Claims 24 - 26. Claim 23, however, also recites that the interactive element is in an activated state to indicate when medication is being delivered and a deactivated state to indicate when no medication is being delivered. The spray counters disclosed in the '030 and '822 patents are designed to track the number of doses rather than when medication is being delivered and do not indicate when medication is being delivered.

Claims 3, 7, 11, 15, 16, 19, and 22 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant deleted the allowable

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claims and added new claims 27-33 that include the limitations of these allowable claims along with the limitations of the base claim and any intervening claims. Specifically, Claim 27 includes the limitations of claims 1-3; Claim 28 includes the limitations of claims 1 and 7; Claim 29 includes the limitations of claims 9-11; Claim 30 includes the limitations of claim 9 and 15; Claim 31 includes the limitations of claims 9 and 16; Claim 32 includes the limitations of claims 17-19; Claim 33 includes the limitations of claims 17 and 22. The Applicant believes that the new claims 23-33 are in a condition of allowance.

All objections and rejections have been fully addressed. No new matter has been entered in this Amendment and Response. It is respectfully submitted that the present Application is in condition for allowance and notice of allowance is earnestly solicited.

Respectfully submitted,

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